

Docket No.: 1614.1142

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Shunji BABA

Serial No. 09/811,605

Group Art Unit: 1762

Confirmation No. 9323

Filed: March 20, 2001

Examiner: Brian K. Talbot

For: RESIN COATING METHOD (AS AMENDED)

**REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION MAILED OCTOBER 3, 2003 AS
PREMATURE MPEP 706.07(c)-(e); AND**

RESPONSE

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action mailed October 3, 2003, and having a period for response set to expire on January 3, 2004. A Petition for a one-month extension of time, together with the requisite fee for same, is submitted herewith, thereby extending the period for response to February 3, 2004.

PREMATURE FINAL REJECTION SHOULD BE WITHDRAWN (MPEP 706.07(c) to (e))

The Office Action is prematurely made final since not "complete as to all matters..." raised in the intervening response: MPEP 707.07 and 37 CFR 1.104 part (b).

Particularly, the final rejection does not comply with MPEP 707.07(f)--Answer All Material Traversed--and which specifically provides:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

(37 CFR 1.104, part (b); emphasis added)

As discussed in the following, item 3 at pages 2-4 of the Action merely repeats, *verbatim*, the rejections in item 3 at pages 2-4 of the prior Office Action mailed April 2, 2003. Particularly, Takamori is the principle reference, relied upon in each of the different groups of rejections:

(1) Takamori is taken in combination with Konishi et al. in the first three rejections (i.e., as to claim 1, claim 3, and claims 6 and 7), at pages 2-3 of the Action;

(2) The combination (1) is taken further with Nakasu et al in the rejection of claims 6 and 7 at pages 3-4 of the Action; and

(3) The expanded combination (2) is taken further with Smith et al. and Yost et al. in the rejection of claims 13-24 at page 4 of the Action.

In the intervening response filed July 23, 2003, each of these references was addressed substantively and the combinations thereof relied upon were addressed, as well, in traversing the rejections. Particularly, applicants set forth detailed distinctions over Takamori, at pages 2-4 of the intervening response over Nakasu at pages 4-5.

Nowhere in item 3, spanning pages 2-4 of the present Action, is any recognition made that the rejections therein repeated were expressly traversed in the intervening response. At page 5 of the Action under the heading "Response to Amendment", the Action asserts, as to applicants' arguments traversing the rejections of record:

Applicant argued that the Takamori reference teaches monitoring "spreading state" and not surface area.

The Examiner disagrees. Takamori teaches monitoring the spreading of the coating which includes the surface area.

Applicant argued that Nakasu teaches monitoring the presence of a drop and not the external appearance.

The Examiner disagrees. Nakasu monitoring of the drop would be inclusive of measuring the "appearance" contrary to Applicant's arguments.

As is apparent, the Examiner in the present Action responds to applicant's arguments regarding only the Takamori and Nakasu references, merely summarily disagreeing with applicant's arguments relating to same and not addressing the "substance" of same.

Moreover, the Examiner in the present Action offers no comments at all regarding the substantive distinctions advanced in the intervening response as to Konishi et al., Smith et al. and Yost et al. (see variously at pages 2-4 of the intervening response) and, moreover, the more extensive discussions of these references in the response filed April 14, 2003, at pages 10-13 and which were incorporated by reference in the intervening response.

Of at least equal significance, the Examiner makes no response to the arguments attacking the lack of *prima facie* obviousness of the combinations of references relied upon, set forth variously in the intervening response and also in the response filed April 14, 2003, pages 11-14, incorporated by reference in the intervening response, as well.

Accordingly, regardless of the issue of whether applicant's arguments addressing Takamori and Nakasu were adequately addressed by the brief comments, *supra*, of the Examiner in item 4 of the final Office Action, the final rejection is clearly incomplete since not even addressing these additional references which are essential to the § 103 rejections and, accordingly is clearly premature and the finality should be withdrawn.

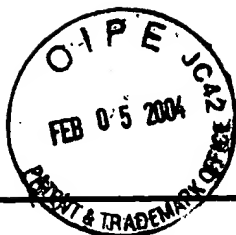
Note that this same circumstance arose in relation to the FINAL Office Action mailed January 9, 2003 herein and the finality of which was attacked on the same grounds as are raised herein--and the same result of the finality being withdrawn logically should follow in the present instance, as well.

Such action is earnestly solicited.

Accordingly, withdrawal of the finality of the Office Action mailed October 3, 2003 is submitted to be proper and the same is earnestly solicited.

RESPONSE

The following amendments and remarks are respectfully submitted. Reconsideration of the claims is respectfully requested.



S&H Form: (10/03)

**REPLY/AMENDMENT
FEE TRANSMITTAL**

Attorney Docket No.	1614.1142
Application Number	09/811,605
Filing Date	March 20, 2001
First Named Inventor	Shunji BABA
Group Art Unit	1762

AMOUNT ENCLOSED

110.00

Examiner Name

Brian K. Talbot

FEE CALCULATION (fees effective 10/01/03)

CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS	12	- 24 =	0	X \$ 18.00 =	\$ 0.00
INDEPENDENT CLAIMS	3	- 10 =	0	X \$ 86.00 =	0.00
Since an Official Action set an <u>original</u> due date of <u>January 3, 2004</u> , petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month (\$110); 2 months (\$420); 3 months (\$950); 4 months (\$1,480); 5					110.00
If Notice of Appeal is enclosed, add (\$330.00)					0.00
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee (\$110.00)					0.00
Information Disclosure Statement (Rule 1.17(p)) (\$180.00)					
Total of above Calculations =					\$ 110.00
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 (b)(1), 1.28)					
TOTAL FEES DUE =					\$ 110.00